

**Amendments to the Drawings:**

The attached replacement sheet of drawings includes changes to FIGs. 5A and 5B. This replacement sheet, which includes FIGs. 5A and 5B replaces the originally-filed sheet including FIGs. 5A and 5B.

In FIG. 5A, reference numeral 59 has been removed, reference numerals 38 and 39 are replaced with 38A and 38B respectively, and a previously-unlabeled item is now labeled as 39.

In FIG. 5B, reference numeral 47 has been added and reference numeral 44 has been replaced with reference numeral 46.

Attachment: Replacement Sheet (1 page)

### **REMARKS/ARGUMENTS**

In the Office Action dated November 1, 2004, the Examiner indicated on page 2 in paragraph 1 that certain of the references listed in the IDS filed on January 12, 2004 were not considered due to failure to identify that these references were previously submitted in a prior application. Accordingly, Applicants are concurrently submitting a new IDS including a list of the crossed-out references with a statement of prior submission of these references. Accordingly, Applicants respectfully request the Examiner to now consider these references.

### **DRAWINGS**

In the above-identified Office Action, the Examiner objected to the drawings for a number of reasons. Specifically, in paragraph 2 on page 3 of the Office Action, the Examiner suggested that reference numeral 38 in FIG. 5A should be renumbered to 38B. The Examiner also said in paragraph 3 on page 3 of the Office Action that the reference character 39 had been used to designate both a glass plate holder as in FIG. 2 and a screw in FIG. 5A. Applicants hereby address both these objections by amending FIG. 5A to conform to the numbering scheme in FIG. 2. Specifically, two screws in FIG. 5A which had been inadvertently labeled as 38 and 39 are now renumbered to be 38A and 38B respectively. Support for this amendment is found at page 8 line 3 of the originally-filed specification as well as in originally-filed FIG. 2. FIG. 5A is further amended by adding reference number 39 to identify the glass plate, which is now in conformance with FIG. 2.

In paragraph 2 on page 3 of the Office Action, the Examiner asked if it is correct that reference numeral 36, i.e. the lower part, is shown above the U-shaped bracket 47 in FIG. 5A and below the U-shaped bracket 47 in FIGs. 5C and 5D. Applicants respectfully traverse this statement. Applicants submit that reference numeral 36 is shown consistently to identify a probe head, which is shown in all three drawings to be below bracket 47.

In case the Examiner was referring to the reference number 46, Applicants respectfully submit that this number has been used to identify a lower part 46 which is held by the U-shaped bracket 47. This lower part 46 is located above bracket 47, passes through bracket 47 and is located below bracket 47. For this reason, reference number 44

in FIG. 5B has been replaced with reference number 46 to correct an error. This correction is supported in the originally-filed specification at page 9 lines 12 and 15.

In paragraph 4 on page 3 of the Office Action, the Examiner objected to FIG. 5B for not containing reference number 47. Accordingly, this reference numeral has now been added to FIG. 5B. Support for this change is at page 9 line 12 of the originally-filed specification.

Also in paragraph 4 on page 3 of the Office Action, the Examiner objected to FIG. 5A for containing reference number 59 which was not discussed in the originally-filed specification. Accordingly, this reference numeral has now been removed from FIG. 5A.

In view of the above-described amendments to the drawings, Applicants respectfully request the Examiner to withdraw all objections to the drawings.

### **SPECIFICATION**

In paragraph 6 on page 4 of the Office Action, the Examiner objected to the abstract because of its relation to the claimed subject matter. Accordingly, the abstract has been amended.

In paragraph 7 on page 5 of the Office Action, the Examiner objected to an informality at page 1. The Specification is amended in accordance with the Examiner's suggestion.

In view of the above-described amendments to the specification, Applicants respectfully request the Examiner to withdraw all objections to the specification.

### **CLAIMS**

Claims 24-29 were objected to in paragraph 8 on page 5 of the Office Action, with the Examiner suggesting that the term "wherein" in Claim 24 be replaced with "further comprising". Claim 24 is rewritten in independent form thereby rendering moot the Examiner's objection.

Claims 27 and 28 were rejected in paragraph 10 on page 5 of the Office Action, because "the magnets" lacked antecedent basis. Claim 27 is now amended to recite "said at least one magnet."

In view of the above remarks, Applicants submit that Claims 22 and 24-29, which were not rejected over the prior art, are now in form for allowance and allowance thereof is respectfully requested.

Applicants respectfully submit that amendments to Claims 22 and 24-29 do not reduce the scope of these claims in any manner. Instead, the amendments merely makes explicit that which was implicit as originally filed. Therefore, Applicants submit that, in making these claim amendments, there has been no loss of equivalents under Festo. If the Examiner believes that claim scope has been narrowed in making these amendments, Applicants respectfully request the Examiner to state the basis for their belief in the next Office Action.

#### **PRIOR ART REJECTION**

Only two claims, namely Claims 21 and 23 were rejected over the prior art. See paragraph 12 on page 6 and top of page 7 of the Office Action. Claim 23 is canceled. Therefore, the following discussion about the prior art is applicable only to Claim 21 and no other claim.

Claim 21 was rejected as being obvious over the teachings of Braunstein (USP 6,057,546) in view of Young (USP 5,705,814). The Examiner cited to Braunstein's patent for disclosing the scanner 20, and a kinematic mounting mechanism 266 supported by the scanner 20. Therefore, the Examiner appears to be citing Braunstein's FIG. 23b although this was not explicitly stated in the Office Action. The Examiner analogized Braunstein's balls 230, 231 and 232 (column 23, lines 3-6) to Claim 21's protrusions, and Braunstein's magnet 246 to Claim 21's magnet. Moreover, the Examiner analogized Braunstein's items 267, 268 and 269 to Claim 21's holes/slots. The Examiner stated that Braunstein fails to disclose a chip mount with a magnet, for which the Examiner relied on Young.

Applicants submit that even if one were to accept the proposed combination of Braunstein and Young as prior art, this combination fails to disclose or suggest that Braunstein's balls 230, 231 and 232 are to mate with Braunstein's items 267, 268 and 269, because this is the analogy that the Examiner made about the corresponding items in Claim 21. As can be seen from Braunstein's FIG. 23b, such mating is impossible because

Braunstein's items 267, 268 and 269 are on an inclined side relative to a horizontal side on which Braunstein's balls 230, 231 and 232 are present.

The Examiner's analogy fails for another reason, because the Examiner analogized Claim 21's hole/slot/flat area to Braunstein's items 267, 268 and 269. However, Braunstein describes these items 267, 268 and 269 as being "three balls" at column 23, line 36. Even assuming that the Examiner is referring to receptacles for the balls, the receptacles are described by Braunstein as being "complementary slots 270, 271 and 272" at column 23, line 37. In contrast, Claim 21 requires a slot, a hole and a flat surface.

In this context, note that although Braunstein discloses a cone, a slot and a flat surface as items 238, 240 and 242, in column 23 at line 7, these items were not cited by the Examiner as being analogized to Claim 21's hole, slot and flat surface.

The Examiner's rejection is defective for yet another reason. The Examiner stated that Young's cantilever 4 is kinematically mounted to probe mount 32, as shown in FIG. 9D of Young's patent. However, the Examiner has misunderstood Young's patent as teaching anything "kinematic" in FIG. 9D. Young's only discussion on FIG. 9D is reproduced below, and as can be seen from the quoted text, there is no indication whatsoever that Young's magnetic mounting system is kinematic:

Magnetic mounting systems (FIG. 9D) can also be used for example if the probe is mounted to a piece of ferromagnetic material 92. Then a probe pickup magnet 94 holds the probe 4 into the probe mount 32 and a probe removal magnet 96 can be used to remove the used probe. Electromagnets would be preferred for this application because they can be turned on and off. Permanent magnets could also be used provided the probe pickup and release is controlled by another mechanism, for example a mechanical clip that prevents the ferromagnetic probe mount 92 from jumping up to the magnet 94 before proper XYZ alignment is achieved. Many other similar probe pickup and release schemes can also be implemented, including combinations of any of the above ideas.

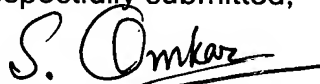
In view of the above arguments, Applicants respectfully submit that even if the teachings of Braunstein and Young are combined in the manner suggested by the Examiner, the combined teachings still fail to disclose or suggest the kinematic mounting mechanism of Claim 21.

Furthermore, Applicants submit that the Examiner has not provided any prior art justification for the statement that there is a need to replace Braunstein's spring clip with Young's magnetic mounting structure. Specifically, the Examiner has failed to explain why would a skilled artisan conclude that Braunstein's spring clip does not provide a secure mounting structure which allows the cantilever to be easily mounted and removed?

In view of the above amendments and remarks, Applicants believe that this application is now in form for allowance and allowance thereof is respectfully requested. Should the Examiner have any questions concerning this paper, the Examiner is invited to call the undersigned at (408) 982-8200, ext. 3.

**Via Express Mail Label No.  
EV 581 853 583 US**

Respectfully submitted,



Omkar K. Suryadevara  
Attorney for Applicants  
Reg. No. 36,320